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Todd T. Taylor  
TAYLOR & AUST, P.C.  
142 s. Main St.  
P.O. Box 560  
Avilla, IN 46710

EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT

PAPER NUMBER

3726

DATE MAILED: 06/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/062,832

Applicant(s)

LEHNER-DITTENBERGER,  
STEFAN

Examiner

Marc Jimenez

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**The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 5-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/9/03 has been entered.

### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: the faxed copy of the declaration received is difficult to read because of the print quality. See also the final rejection mailed 3/21/03 requesting a new oath or declaration.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. **Claims 1, 2, and 5-29** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "at least one rigid support ring into which said base body is inserted" added to claims 1 and 10 constitutes new matter. There is no support in the original disclosure for a rigid support ring into which the base body is inserted because the original disclosure describes the "rigid support points" (numeral **26** in applicant's drawings) are formed, at least partially, by the base body itself (page 3, lines 19-20 of applicant's specification). Applicant's response filed 6/9/03 does not indicate where in the original disclosure that there is support for the rigid support ring into which the base body limitation is found. It is noted that the disc spacer **38** shown in applicant's fig. 2 is distinguished from being a "support ring" because it is described as "a spacer" in claim 29 and the disc spacer **38** is not described as being rigid. See also advisory action mailed 5/28/03 which indicated that the amendments to the claims raises new matter issues.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 10-12** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 10 recites the broad recitation "at least one resilient member being at least one of a resilient layer applied to at least sections of said body and at least one resilient element", and the claim also recites "said at least one resilient member is a said resilient layer" which is the narrower statement of the range/limitation.

In claim 10, lines 13-14, the limitation "said radial rigidity of each said resilient member varying over said roller length" contradicts the limitation in claim 11, lines 8-9 which recites "said resilient layer having a constant radial rigidity over an axial length thereof" and therefore renders the scope of the claims unclear.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 1, 2, 5-8, 13, 15, and 17-22** are rejected under 35 U.S.C. 102(b) as being anticipated by Nelson (4,974,782).

Nelson teaches a roller for winding of a material web thereon, the roller having two roller ends and a mid roller area, the roller having a maximum winding diameter associated therewith, the roller comprising: a base body **35** being substantially cylindrical, at least one rigid support ring **60a** into which the base body **35** is inserted, at least one resilient member **60**, the at least one resilient member **60** being at least one resilient element **60** (fig. 3) positioned on the base body **35**, the at least one resilient member **60** being positioned and configured so as to make the roller radially more resilient near each of the roller ends than in the mid-roller area (abstract, last five lines) in order to at least partially compensate for a deflection of the base body **35** at the maximum winding diameter, the roller has a roller length, each resilient member **60** having a radial rigidity, the radial rigidity of each resilient member **60** varying over the roller length (abstract, last five lines), and a circumferential surface **30** positioned over the base body **35**, the circumferential surface **30** contacting the material web, the circumferential surface **30** in contact with the at least one rigid support ring **60a**, the circumferential surface **30** being one of integral with and separate from the at least one resilient member **60**.

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Regarding claim 2, the material web being a paper web does not further limit the structural features of the claimed roller and therefore has not been given patentable weight. Furthermore, it is noted that it is inherent that the roller of Nelson is used for paper webs because it is used for pressure treating sheets in imaging systems (col. 1, lines 9-12 and col. 2, lines 60-63). Also, It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claims 5-7, note that there are rigid support points at the mid point of the base body **35** and axially along the base body which are surrounded by the circumferential surface **30**, the circumferential surface **30** being radially less resilient in a vicinity of the rigid support point on the mid point than near the two roller ends (abstract, last two lines). The claimed "rigid support points" have no defined structure, but are merely "points" along the base body.

Regarding claim 8, the circumferential surface **30** comprises a resilient tube surrounding the base body **35**, the at least one resilient member **60** being positioned radially between the base body **35** and the resilient tube **30**.

Regarding claim 13, the at least one resilient member **60** is a resilient layer, the resilient layer **60** being a layer comprised of one of rubber and another elastomeric material (col. 2, lines 4-8).

Regarding claim 15, the circumferential surface **30** comprises a resilient tube surrounding the base body **35**, the at least one resilient member **60** being a resilient layer, the resilient layer

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60 being provided near the two roller ends and being positioned between the base body 35 and the resilient tube 30.

Regarding claim 17, the at least one resilient member 60 is a resilient layer, the resilient layer 60 having a constant thickness over an axial length thereof, the resilient layer 60 increasing in radial resilience toward each of the two roller ends (abstract, last five lines), the resilient layer 60 being applied on the base body 35 at least near each of the two roller ends.

Regarding claim 18, the at least one resilient member 60 is a plurality of resilient elements (see fig. 3), the roller having a roller axis, the resilient elements 60 being axially distanced from one another at a respective axial spacing relative to the roller axis, each resilient member 60 having a respective resilience, at least one of the respective axial spacing being appropriately chosen and the respective resilience varying appropriately in order to render the circumferential surface comparatively more resilient near the two roller ends than in the mid-roller area (abstract, last five lines).

Regarding claim 19, the at least one resilient member 60 is a plurality of resilient elements, each resilient element 60 at least partially comprising one discrete spring element 60.

Regarding claim 20, the resilient element 60 at least partially comprises one annular body formed of one of rubber or another elastomeric material (col. 2, lines 4-8).

Regarding claim 21, the resilient elements 60 are "spring packets". See also U.S. patent no. 3,750,246 to Pesson who defines resilient elements as being "spring packets" (col. 12, line 53).

Regarding claim 22, the resilient elements 60 are prestressed by force F.



***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claim 9, 14, 16, and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson.

Regarding claims 9 and 16, Nelson teaches the invention cited with the exception of the resilient tube being a coating of rubber or another elastomeric material.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have selected the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

Furthermore, on page 3, last two lines to page 4, first line of applicant's specification, the particular use of resilient material could be metal, rubber, or other similar material. Therefore, at the time of the invention, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have used rubber or other elastomeric material for the tube, because applicant has not disclosed that using rubber or other elastomeric material provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art,

furthermore, would have expected applicant's invention to perform equally well with either the metal tube taught by Nelson or the claimed resilient tube material because either type of material for the tube perform the same function of covering the resilient member equally well. Therefore, it would have been an obvious matter of design choice to modify Nelson to obtain the invention as specified in claims 9 and 16.

Regarding claim 14, Nelson teaches the invention cited with the exception of the at least one resilient member being formed of a non-homogeneous layer of at least one of a foamed material and a honeycomb structure.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have selected the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

Furthermore, at the time of the invention, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have used at least one resilient member being formed of a non-homogeneous layer of at least one of a foamed material and a honeycomb structure, because applicant has not disclosed that using at least one resilient member being formed of a non-homogeneous layer of at least one of a foamed material and a honeycomb structure provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either the resilient material taught by Nelson or the claimed resilient material because either type of material perform the same function providing a resilient layer equally

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well. Therefore, it would have been an obvious matter of design choice to modify Nelson to obtain the invention as specified in claim 14.

Regarding claim 23, Nelson teaches the invention cited with the exception of the base body **35** being hollow. Official notice is taken that it was well known in the art to a person of ordinary skill in the art, to have used a hollow base body in order to reduce the weight of the base body.

11. **Claims 10-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Pessen (3,750,246) in view of Nelson.

Pessen teaches a roller for winding of a material web thereon, the roller having two rollers ends and a mid-roller area, the roller having a maximum winding diameter associated therewith, the roller comprising: a base body **B**, at least one rigid support **22**, at least one resilient member **D**, the at least one resilient member **D** being at least one of a resilient layer applied to at least sections of the body **B** and at least one resilient element positioned on the base body **B**, the at least one resilient member **D** is a resilient layer, the resilient layer **D** having a constant radial rigidity over an axial length thereof, the resilient layer **D** increasing in thickness toward each of the two roller ends **A**, the resilient layer **D** being applied on the base body **B** at least near each of the two roller ends **A** in order to at least partially compensate for a deflection of the base body **B** at the maximum winding diameter, the roller has a roller length, each resilient member having a radial rigidity, a circumferential surface **C** positioned over the base body **B**, the circumferential surface **C** contacting the material web, the circumferential surface **C** in contact

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with the at least one rigid support **22**, the circumferential surface **C** being one of integral with and separate from the at least one resilient member **D**.

Pesson teaches the invention cited with the exception of the rigid support being a "rigid support ring" into which the base body is inserted and the radial rigidity of the resilient member varying over the roller length.

Nelson teaches a radial rigidity of a resilient member **38** varying over the roller length (col. 3, lines 14-20).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Pesson with the radial rigidity of the resilient member varying over the roller length, in light of the teachings of Nelson, in order to obtain the desired variable modulus as suggested by Nelson at col. 3, lines 19-20.

Regarding the "rigid support ring" limitation, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have separated the rigid support **22** of Pesson, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

12. **Claims 24-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Pessen (3,750,246).

Nelson teaches the invention cited above (see also fig. 1) with the exception of having tension anchors.

Pessen teaches tension anchors **H** (col. 7, lines 14-33).

It would have been obvious to one of ordinary skill in the, at the time of the invention, to

have provided the invention of Nelson with tension anchors, in light of the teachings of Pessen, in order to securely hold the resilient layer in place. Note that Pessen also teach spacers **92**.

Regarding claims 25 and 26, the particular arrangement of the tension anchors is clearly a matter of obvious design choice because applicant has not disclosed that a parallel, approximately parallel, traverse diagonal, or spiral configuration of the tension anchors relative to the base body provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either the anchor **H** arrangement taught by Pesson or the claimed arrangement, because either arrangement would work equally well in holding the resilient layer in place.

Regarding claim 27, Pessen teaches at least two outer walls **92** (one on each side of the roller) with the tension anchors braced by the outer walls.

Regarding claim 28, the tension anchors **H** are braced in a rectangular manner by the spacer **92**.

Regarding claim 29, note the spacer **92**.

### ***Response to Arguments***

13. Applicant's arguments with respect to claims 1, 2, and 5-29 have been considered but are moot in view of the new ground(s) of rejection.

14. In response to applicant's argument that Nelson does not teach "at least one rigid support ring into which the base body is inserted", it is noted that the center element **50** in fig. 2, element labeled **60a** in fig. 3, and element to the right of lead line **70a** could be considered a "rigid

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support ring” because it supports the center part of the circumferential surface **30** and is mounted on top of the base body **35**. Furthermore, it is noted that the limitation “at least one rigid support ring into which the base body is inserted” constitutes new matter because the original disclosure does not have support for a rigid support ring into which a base body is inserted. See 35 U.S.C. 112 1<sup>st</sup> paragraph rejection above.

### ***Contact Information***

15. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to

[CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is **703-306-5965**.

The examiner can normally be reached on **Monday-Friday, between 5:30 am- 2:00 pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone numbers for

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the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 308-6789 or (888) 786-0101
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Marc Jimenez  
Patent Examiner  
AU 3726

**MJ**  
June 19, 2003